

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**(Case No. 97,022-B1)**

PATENT

In re Application of:

**R. Terry Dunlay, et al.**

Serial No.: 09/723,256

**Filed: November 27, 2000**

For: **A System for Cell-Based Screening**

**Art Unit: 1631**

Examiner: **C. Smith**

Conf. No. **5678**

## **SUPPLEMENTAL** **INFORMATION DISCLOSURE STATEMENT**

**Mail Stop: IDS  
Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450**

Dear Sir:

Pursuant to 37 C.F.R. Section 1.97 - 1.99, the Applicant wishes to make the following references of record in the above-identified application. This Information Disclosure Statement is in compliance with the continuing duty of candor as set forth in 37 C.F.R. Section 1.56. Copies of the references cited below are enclosed. These references are also listed on the enclosed PTO Form 1449.

In the judgment of the undersigned, portions of the listed references may be material to the Examiner's consideration of the presently pending claims. However, the references have not been reviewed in sufficient detail to make any other representation and, in particular, no representation is intended as to the relative relevance between references, whether cited in this or prior statements. This statement is not a representation that the listed references have effective dates early enough to be "prior art" within the meaning of 35 U.S.C. Section 102 or Section 103.

01/29/2004 SMINASS1 00000003 132490 09723256

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**McDonnell, Boehnen, Hulbert & Berghoff**  
**300 S. Wacker Drive, Suite 3200**  
**Chicago, IL 60606**  
**312-913-0001**

This Information Disclosure Statement is being filed:

- ☐ within three months of the filing date of a national application; within three months of the date of entry into the national stage as set forth in 37 C.F.R. § 1.491 in an international application; or before the mailing date of a first Office Action on the merits. 37 C.F.R. § 1.97 (b)
- ☒ **after** three months of the filing date of a national application, or the date of entry into the national stage as set forth in 37 C.F.R. § 1.491 in an international application; or **after** the mailing date of a first Office Action on the merits, but **before** the mailing date of a Final Action under 37 C.F.R. § 1.113 or a Notice of Allowance under 37 C.F.R. § 1.311 (whichever occurs first), and includes (37 C.F.R. § 1.97 (c):
- ☐ the Certification under 37 C.F.R. § 1.97(e) (see "Certification" below)

OR

- ☒ the fee of \$180.00 set forth in 37 C.F.R. § 1.17(p) (see "Fees" below).
- ☐ **after** a Final Action under 37 C.F.R. § 1.113 or a Notice of Allowance under 37 C.F.R. § 1.311 (whichever occurs first), but before, or simultaneously with, the payment of the issue fee, and includes the Certification under 37 C.F.R. § 1.97(e) (see "Certification" below), and the Petition Fee set forth in 37 C.F.R. § 1.17(i) (see "Fees" and "Method of Payment of Fees" below). Applicants hereby petitions for consideration of the Information Disclosure Statement submitted herewith and the accompanying references in examination of the subject patent application.

#### CERTIFICATION

- ☐ The **undersigned** hereby certifies that each item of information contained in the Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign patent application not more than three months prior to the filing of the Information Disclosure Statement.
- ☐ The **undersigned** hereby certifies that no item of information contained in the Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign patent application or, to the knowledge of the person signing the certification after making reasonable inquiry, was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of the Information Disclosure Statement.

**FEES**

- ☐ No fee is owed by the applicant(s).  
☒ The **IDS Fee of \$180.00** under 37 C.F.R. § 1.17(p) is enclosed herewith.

**METHOD OF PAYMENT OF FEES**

- ☐ Attached is a check in the amount of \$180.00  
☒ Charge Deposit Account No. 13-2490 in the amount of \$180.00. (A duplicate copy of this communication is enclosed for that purpose.)

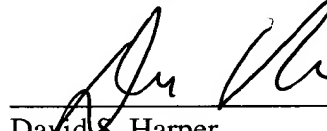
Please charge any underpayment or credit any overpayment in connection with this communication to Deposit Account No. 13-2490. A duplicate copy of this communication is enclosed for this purpose.

**CERTIFICATE OF MAILING VIA EXPRESS MAIL DELIVERY under 37 C.F.R. § 1.10.** I hereby certify that the attached paper of fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" Service under 37 C.F.R. § 1.10 on the date indicated above and is addressed to Commissioner for Patents, MAIL STOP: RESPONSE, PO Box 1450, Alexandria, VA 22313-1450 on this 23<sup>rd</sup> day of January, 2004. Express Mail No. EV333557231US.

Date: \_\_\_\_\_

1/23/04

Respectfully submitted,



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Registration No. 42,636

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**U.S. Patent References:**

1. Dennis R. Morrison, U.S. Patent No. 5,869,238, Issued on February 9, 1999.
2. Jeffrey H. Price, et al., U.S. Patent No. 5,548,661, Issued on August 20, 1996.
3. Davis R. Walt, et al., U.S. Patent No. 6,210,910, Issued April 3, 2001.
4. Richard M. Kris, et al., U.S. Patent No. 6,238,869, Issued May 29, 2001.
5. R. Terry Dunlay, et al., U.S. Patent No. 6,671,624, Issued December 30, 2003.
6. R. Terry Dunlay, et al., U.S. Patent No. 6,573,039, Issued June 3, 2003.
7. R. Terry Dunlay, et al., U.S. Patent No. 6,620,591, Issued September 16, 2003.

**U.S. Published Patent Applications:**

9. R. Terry Dunlay, et al., U.S. Published Patent Application No. 2003/0204316 A1.

**Commonly owned Co-Pending Cellomics, Inc. U.S. Patent Applications:**

U.S. Serial No. 09/721,168 Filed November 22, 2000 (Our Case No. 97,022-G1)  
U.S. Serial No. 10/411,635 Filed April 11, 2003 (Our Case No. 97,022-G-CO)  
U.S. Serial No. 10/686,161 Filed October 15, 2003 (Our Case No. 97,022-B2-CO)  
U.S. Serial No. 09/380,259 Filed February 27, 1998 (Our Case No. 97,022-C4)  
U.S. Serial No. 09/352,171 Filed July 12, 1999 (Our Case No. 97,022-D1)  
U.S. Serial No. 09/598,347 Filed June 21, 2000 (Our Case No. 97,022-D3)

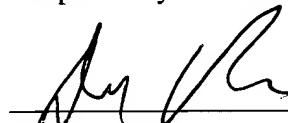
In accordance with MPEP Sections 609 and 707.05(b), it is requested the document cited be given thorough consideration and that it be cited of record in the prosecution history of the present application by initialing on Form PTO-1449. Such initialing is requested even if the Examiner does not consider a cited document to be sufficiently pertinent to use in a rejection, or otherwise does not consider it to be prior art for any reason, or even if the Examiner does not believe that the guidelines for citation have been fully complied with. This is requested so that each document becomes listed on the face of the patent issuing on the present application.

Respectfully Submitted,

Date:

1/23/04

By:



David Harper

Reg. No. 42,636

FORM PTO-1449  
(Rev. 2-32)

U.S. Department of Commerce  
Patent and Trademark Office



**SUPPLEMENTAL  
INFORMATION DISCLOSURE  
STATEMENT BY APPLICANT**

(Use several sheets if necessary)

Atty. Dock t N .

97,022-B1

Serial No.

09/723,256

**Applicant:**

R. Terry Dunlay, et al.

**Filing Date:**

November 27, 2000

**Group:**

1631

**U.S. PATENT DOCUMENTS**

Examiner Initial		Document Number	Date	Name	Class	Subclass	Filing Date if Appropriate
	1.	5,869,238	2-9-99	Dennis R. Morrison			2-16-95
	2.	5,548,661	8-20-96	Jeffrey H. Price, et al.			9-7-94
	3.	6,210,910	4-3-01	David R. Walt, et al.			3-2-98
	4.	6,238,869	5-29-01	Richard M. Kris, et al.			6-21-99
	5.	6,671,624	12-30-03	R. Terry Dunlay, et al.			11-27-00
	6.	6,573,039	6-3-03	R. Terry Dunlay, et al.			8-29-00
	7.	6,620,591	9-16-03	R. Terry Dunlay, et al.			4-16-99

**FOREIGN PATENT DOCUMENTS**

		Document Number	Date	Country	Class	Subclass	Translation	
							Yes	No

**OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc).**

	8.	U.S. Published Patent Application No. US 2003/0204316 A1, Published on October 30, 2003.

EXAMINER

DATE CONSIDERED

EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication.

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